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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,135	06/01/1999	CHRISTIAN LAROQUE	Q054622	8820
23373 7590 01/10/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER MOORE JR, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2616	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/10/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/323,135

Applicant(s)

LAROQUE ET AL.

Examiner

Michael J. Moore, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Replacement drawings were received on 6/5/2003. These drawings are acceptable and have been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim **12** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, claim **12** recites the limitation “regardless of the destination for the signaling message” on lines 5-6. Upon Examiner reviewing the rejections made in the previous Office Action, it is believed that the issue revolves around the phrase “regardless of the destination”. After reviewing Applicant’s arguments, it is understood by Examiner that this limitation is intended to mean that “the same predetermined constant character string” is used to replace the receive flag regardless of where the signaling message is to be sent.

However, based on the current claim language, as claim **12** currently depends upon claim **2**, “the destination” claimed in claim **12** corresponds to “the destination” on line 8 of claim **2**, as well as “a destination” on line 5 of claim **2**. There is some confusion

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resulting from this claim language, because the specification as well as Figure 2 disclose that the translator replaces the flag with the predetermined constant character string based upon the destination of the signaling message. If the current switch is the destination of the signaling message, then normal processing takes place. However, if the current switch is not the destination of the signaling message, then the receive flag is replaced.

Therefore, it is held that claiming "the translator replaces the receive flag with the predetermined constant character string regardless of the destination for the signaling message" contradicts the original specification and drawings. A suggestion would be to amend claim **12** to indicate instead that the "predetermined constant character string" used is always the same.

Applicant's arguments with respect to claim **13** are persuasive and thus the previous rejection of claim **13** under 35 U.S.C. 112, 1st paragraph is withdrawn.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims **1-16** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims **1, 2, 7-13, 15, and 16** are directed to an apparatus (switch) including a judicial exception (interpreter is a computer program/software or "functional descriptive material *per se*") with no claimed practical application.

Claims **3-6 and 14** are directed to a method including a judicial exception (interpreting through a computer program/software or “functional descriptive material *per se*”) with no claimed practical application.

See MPEP 2106.01 [R-5] (Computer-Related Nonstatutory Subject Matter).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims **1-16** are rejected under 35 U.S.C. 102(e) as being anticipated by Dunn et al. (U.S. 6,324,280) (hereinafter “Dunn”). *Dunn* teaches all of the limitations of the specified claims with the reasoning that follows.

Regarding claim 1, “a switch” is anticipated by the originating switch 1 of Figure

1.

“A coupler accessing signaling channels to transmit signaling messages” is anticipated by network 6 (coupler) of switch 1 used for establishing connections between the PSTN and the Internet or toll network as spoken of on column 2, lines 53-55.

“An interpreter producing a signaling configuration upon receiving an order to send a signaling message, wherein a type of signaling channel is selected from the

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signaling channels accessible to the coupler and the signaling configuration produced depends on the selected type of signaling channel" is anticipated by processor 5 (interpreter) of switch 1 of Figure 1 that receives a request (order) to establish a connection from originating station 25, analyzes the digits of the call request, determines whether to route the call either over the Internet or the toll network based on the analysis, and then generates appropriate call setup signaling (configuration) for either the toll network (conventional call setup) or the Internet (IAM message) as spoken of on column 4, lines 5-18.

"A receiver for adding a receive flag to a received signaling message" is anticipated by terminating toll switch 2 (receiver) that in response to receipt of initial address message (IAM) 40, returns an IAM acknowledgement containing the same call ID as well as an added field IP 2 47 indicating the IP address of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50.

Lastly, "wherein the order is a predetermined constant character string" is anticipated by the call origination containing dialed digits (string) as spoken of on column 3, lines 18-21 as well as column 4, lines 5-8.

Regarding claim 2, "a detector recognizing whether the received signaling message is addressed to the switch" is anticipated by terminating toll switch 2 that receives an initial address message (IAM) 40 indicating the IP address of the originating switch 1 as spoken of on column 3, lines 39-45.

"A processor processing the signaling message when the switch is a destination for the signaling message" is anticipated by terminating toll switch 2 that in response to

receipt (processing) of initial address message (IAM) 40, returns an IAM acknowledgement containing the same call ID as well as an added field IP 2 47 indicating the IP address of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50.

Lastly, "a translator replacing the receive flag with the predetermined character string when the switch is not the destination for the signaling message" is anticipated by terminating toll switch 2 that responds to a packet identifying the call associated with its identification by sending a packet containing the same call identifier replaced with an identifier of the originating switch 1 as spoken of on column 3, lines 63-67.

Regarding claim 3, "adding to the signaling message a predetermined send order for the signaling message, the adding further comprises the switch receiving the signaling message in a receiving exchange and adding a receive flag to the signaling message" is anticipated by a request (send order) to establish a connection from originating station 25, as well as terminating toll switch 2 (switch) that in response to receipt of initial address message (IAM) 40, returns an IAM acknowledgement containing the same call ID as well as an added field IP 2 47 (receive flag) indicating the IP address of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50.

"Interpreting the send order in an interpreter of the switch to produce a signaling configuration of the switch, the signaling configuration produced depends on a selected type of signaling channel, wherein the type of signaling channel is selected from the signaling channels available to the switch" is anticipated by processor 5 (interpreter) of

switch 1 of Figure 1 that receives a request (order) to establish a connection from originating station 25, analyzes the digits of the call request, determines whether to route the call either over the Internet or the toll network (types of signaling channels) based on the analysis, and then generates appropriate call setup signaling (configuration) for either the toll network (conventional call setup) or the Internet (IAM message) as spoken of on column 4, lines 5-18.

Lastly, "wherein the receive flag is a specified constant and the predetermined send order is a specified constant character string" is anticipated by the IAM acknowledgement containing the same call ID as well as an added field IP 2 47 (receive flag) indicating the IP address (specified constant) of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50, as well as the call origination containing dialed digits (character string) as spoken of on column 3, lines 18-21 as well as column 4, lines 5-8.

Regarding claim 4, "the destination of the signaling message is tested, and if a destination of the signaling message is different from the receiving exchange, the flag is replaced by the predetermined character string" is anticipated by terminating toll switch 2 that responds to a packet identifying the call associated with its identification by sending a packet containing the same call identifier replaced with an identifier of the originating switch 1 as spoken of on column 3, lines 63-67.

Regarding claim 5, "wherein the interpreter is configured to process at least one of: an IP protocol, a frame relay protocol, an ATM protocol, a switched X25 protocol, a

generic modem protocol, and a switched B channel protocol" is anticipated by the IP communication shown in Figure 1.

Regarding claim 6, "wherein the interpreter is one of a microprocessor associated with a program and a working session in a processor running the switch" is anticipated by processor 5 (microprocessor) of the switch 1 of Figure 1.

Regarding claim 7, "wherein the interpreter comprises a circuit configured to process at least one of: an IP protocol, a frame relay protocol, an ATM protocol, a switched X25 protocol, a generic modem protocol, and a switched B channel protocol" is anticipated by the IP communication shown in Figure 1.

Regarding claim 8, "wherein the interpreter comprises one of a microprocessor associated with a program and a working session in a processor running the switch" is anticipated by processor 5 (microprocessor) of the switch 1 of Figure 1.

Regarding claim 9, "a switch" is anticipated by the originating switch 1 of Figure 1.

"A coupler accessing signaling channels to transmit signaling messages" is anticipated by network 6 (coupler) of switch 1 used for establishing connections between the PSTN and the Internet or toll network as spoken of on column 2, lines 53-55.

"An interpreter producing a signaling configuration upon receiving an order to send a signaling message, wherein a type of signaling channel is selected from the signaling channels accessible to the coupler and the signaling configuration produced depends on the selected type of signaling channel" is anticipated by processor 5

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(interpreter) of switch 1 of Figure 1 that receives a request (order) to establish a connection from originating station 25, analyzes the digits of the call request, determines whether to route the call either over the Internet or the toll network based on the analysis, and then generates appropriate call setup signaling (configuration) for either the toll network (conventional call setup) or the Internet (IAM message) as spoken of on column 4, lines 5-18.

"A receiver for adding a receive flag to a received signaling message" is anticipated by terminating toll switch 2 (receiver) that in response to receipt of initial address message (IAM) 40, returns an IAM acknowledgement containing the same call ID as well as an added field IP 2 47 indicating the IP address of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50.

"Wherein the order is a predetermined constant character string" is anticipated by the call origination containing dialed digits (string) as spoken of on column 3, lines 18-21 as well as column 4, lines 5-8.

"A detector recognizing whether the received signaling message is addressed to the switch" is anticipated by terminating toll switch 2 that receives an initial address message (IAM) 40 indicating the IP address of the originating switch 1 as spoken of on column 3, lines 39-45.

"A processor processing the signaling message when the switch is a destination for the signaling message" is anticipated by terminating toll switch 2 that in response to receipt (processing) of initial address message (IAM) 40, returns an IAM acknowledgement containing the same call ID as well as an added field IP 2 47

indicating the IP address of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50.

"A translator replacing the receive flag with the predetermined character string when the switch is not the destination for the signaling message" is anticipated by terminating toll switch 2 that responds to a packet identifying the call associated with its identification by sending a packet containing the same call identifier replaced with an identifier of the originating switch 1 as spoken of on column 3, lines 63-67.

Lastly, "wherein the coupler has a plurality of interfaces, wherein each of the interfaces provides access to one of the channels and wherein when a plurality of signaling channels are available to transmit the signaling messages, a next available signaling channel is selected in a chronological order and the signaling message is configured to produce the signaling configuration for the next available signaling channel" is anticipated by the signaling messages 40, 45, 50, 55 transmitted via CCS7 network 5 (interface) as well as Internet 10 (interface) as shown in Figure 1.

Regarding claim **10**, "wherein the predetermined constant character string remains unchanged regardless of a type of the available signaling channels" is anticipated by the call origination containing dialed digits (character string) as spoken of on column 3, lines 18-21 as well as column 4, lines 5-8.

Regarding claim **11**, "wherein when the signaling message is received by the switch, the receiver adds a receive flag to the signaling message and the detector checks the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message" is anticipated by terminating toll

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switch 2 (receiver) that in response to receipt of initial address message (IAM) 40, returns an IAM acknowledgement containing the same call ID as well as an added field IP 2 47 (receive flag) indicating the IP address of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50.

Regarding claim **12**, "when the detector recognizes that the received signaling message is not addressed to the switch, the detector forwards the received signaling message to the translator, and wherein, when the translator receives the signaling message from the detector, the translator replaces the receive flag with the predetermined constant character string regardless of the destination for the signaling message" is anticipated by terminating toll switch 2 that responds to a packet identifying the call associated with its identification by sending a packet containing the same call identifier replaced with an identifier of the originating switch 1 as spoken of on column 3, lines 63-67.

Regarding claim **13**, "wherein when the switch is not the destination, the translator replaces the receive flag with the predetermined constant character string regardless of the signaling configuration of the signaling message" is anticipated by terminating toll switch 2 that responds to a packet identifying the call associated with its identification by sending a packet containing the same call identifier replaced with an identifier of the originating switch 1 as spoken of on column 3, lines 63-67.

Regarding claim **14**, "wherein, when the switch adds the send order to the signaling message, the switch selects the type of signaling channel from the signaling channels available at the switch for transmitting the signaling message, and the

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interpreter of the switch produces the signaling configuration for the signaling message based on the selected type of signaling channel” is anticipated by processor 5 (interpreter) of switch 1 of Figure 1 that receives a request (order) to establish a connection from originating station 25, analyzes the digits of the call request, determines whether to route the call either over the Internet or the toll network based on the analysis, and then generates appropriate call setup signaling (configuration) for either the toll network (conventional call setup) or the Internet (IAM message) as spoken of on column 4, lines 5-18.

Regarding claim **15**, “a switch” is anticipated by the originating switch 1 of Figure 1.

“A coupler accessing signaling channels of different types to transmit signaling messages” is anticipated by network 6 (coupler) of switch 1 used for establishing connections between the PSTN and the Internet or toll network (different types) as spoken of on column 2, lines 53-55.

“An interpreter producing a signaling configuration upon receiving an order to send a signaling message, wherein the signaling configuration produced for the signaling message depends on a selected type of signaling channel, and wherein the type of signaling channel is selected from different types of the signaling channels available at the coupler to transmit signaling messages” is anticipated processor 5 (interpreter) of switch 1 of Figure 1 that receives a request (order) to establish a connection from originating station 25, analyzes the digits of the call request, determines whether to route the call either over the Internet or the toll network based on

the analysis, and then generates appropriate call setup signaling (configuration) for either the toll network (conventional call setup) or the Internet (IAM message) as spoken of on column 4, lines 5-18.

“A receiver for adding a receive flag to a received signaling message” is anticipated by terminating toll switch 2 (receiver) that in response to receipt of initial address message (IAM) 40, returns an IAM acknowledgement containing the same call ID as well as an added field IP 2 47 indicating the IP address of the terminating toll switch 2 as shown in Figure 1 and spoken of on column 3, lines 45-50.

“Wherein the order is a predetermined constant character string” is anticipated by the call origination containing dialed digits (string) as spoken of on column 3, lines 18-21 as well as column 4, lines 5-8.

Lastly, “wherein the selection of the type of signaling channel for producing the signaling configuration is based on a predetermined criteria” is anticipated by the choice of routing the call either over the Internet or over the toll network based on factors such as the present state of the networks, customer input, or dialed information (criteria) as spoken of on column 3, lines 10-21.

Regarding claim 16, “wherein the coupler has a plurality of interfaces, wherein each of the interfaces provides access to one of the channels, and wherein when a plurality of signaling channels are available to transmit the signaling message, an available signaling channel is selected based on the predetermined criteria and the signaling message is configured to produce the signaling configuration for the available

signaling channel" is anticipated by the signaling messages 40, 45, 50, 55 transmitted via CCS7 network 5 (interface) as well as Internet 10 (interface) as shown in Figure 1.

Response to Arguments

7. Applicant's arguments with respect to claims **1-8 and 11-13** have been considered but are moot in view of the new ground(s) of rejection provided above.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cohn et al. (U.S. 6,411,684) is another reference considered pertinent to this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Moore, Jr. whose telephone number is (571) 272-3168. The examiner can normally be reached on Monday-Friday (8:00am - 4:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached at (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Michael J. Moore, Jr.
Examiner
Art Unit 2616

mjm MM

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